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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/765,847 | 01/19/2001 | Jose C. Brustoloni | Brustoloni 8-5 | 9246 |

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EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,847

Applicant(s)

BRUSTOLONI ET AL.

Examiner

Carl Colin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/19/01. 6) ☐ Other: _____

DETAILED ACTION

1. Pursuant to USC 131, claims 1-57 are presented for examination.

Specification

2. The disclosure is objected to because of the following informalities: on page 4, line 21, link to the Internet 114 is not consistent with link 114 Internet 115 on page 1, lines 30-31. Appropriate correction is required. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

- 2.1 The abstract of the disclosure is objected to because of the following informality on page 36 line 11, "in" should be replaced by --In--.

- 2.2 The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable codes (see page 23, line 15). Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable codes. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1 Regarding **claim 57**, the phrase "sent from the" on page 34, line 33, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "substantially similar"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(b).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 1-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,128,601 to **Van Horne et al.** in view of US Patent Publication US 2002/0019875 to **Garrett et al.** and in view of US Patent 6,023,499 to **Mansey et al.**

4.2 As per claims 1, 2, 50, 53 and 57, **Van Horne et al.** substantially teaches a method and apparatus for providing client access to the Internet or other network, comprising: offering, at a point of service, a Local Area Network (LAN) connected to the Internet or other network, for example (see column 4, lines 10-65 and column 3, lines 20-48); connecting at least one client computer to said LAN, for example (see column 4, lines 10-65 and column 3, lines 20-48); configuring networking parameters of each of said at least one client computer, for example (see column 4, lines 38-65 and column 10, lines 37-67); establishing a secure connection between the service provider and each of said at least one client computer, such that the service provider provides Internet or other network service through the secure connection to only each one of said at least one client computer, for example (see column 4, lines 38-65 and column 10, lines 37-67; and providing the Internet or other network service at the point of service to each one of the at least one client computer in accordance with the network usage terms and prices, for example (see column 4, lines 10-65 see also columns 17 et seq.). **Van Horne et al.** discloses establishing a secure connection between the client and the service provider, but does not explicitly state using "a secure tunnel", which is well known in the art. **Garrett et al.** in an analogous art teaches establishing a secure tunnel between the service provider and each of said at least one client computer, such that the service provider provides Internet or other network service through the secure tunnel to only each one of said at least one client computer in order to encapsulate traffic and provide initialization and authentication procedures between the service provider and the client, for example (see page 3, paragraph 0020). **Garrett et al.** also discloses to implement the invention using a number of different communication protocols, such Internet protocols are

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very well known in the art as disclosed, for example (see page 1, column 0010). For instance RFC 1426 and 1826 discuss Certificate Key-Based Management, exchanging authentication certificates, IP authentication header, packet encryption, and Certificate Authority, etc.. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Van Horne et al.** to establish a secure tunnel between the service provider and each of said at least one client computer by exchanging authentication certificate, such that the service provider provides Internet or other network service through the secure tunnel to only each one of said at least one client computer to encapsulate traffic and provide initialization and authentication procedures between the service provider and the client as taught by **Garrett et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Garrett et al.** so as to encapsulate traffic and provide initialization and authentication procedures between the service provider and the client, for example (see page 3, paragraph 0020).

Van Horne et al. discloses selecting billing options at the point of service, and also discloses billing preferences, and network usage terms and prices with each one of said at least one client computer, for example (see column 4, lines 10-65 see also column 18 lines 41 et seq.); It is obvious to one skilled in the art that the billing options and preferences disclosed by **Van Horne et al.** may also imply the selection of term and prices which does not depart from the spirit and scope of the invention as at the end of the session a display of usage and prices is shown for example in figure 16. **Mansey et al.** in an analogous art teaches a method of monitoring charges associated to any types of communication networks, for example (see column 3, line 55 through column 4 line 5); negotiating, at the point of service, the network

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usage terms and prices with each one of said at least one client computer, for example (see column 1, line 60 through column 2, line 40) and accessing said Internet via said service provider according to said negotiated usage terms, for example (see column 5, lines 45-65). **Mansey et al.** further discloses that the invention is advantageous as it provides continuous tracking and displaying of the running costs during usage of the service and allows the user to define a maximum cost limit for a particular use of the service and accessing said Internet via said service provider according to said negotiated usage terms, for example (see column 2, lines 21-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Van Horne et al.** to negotiate, at the point of service, the network usage terms and prices with each one of said at least one client computer as taught by **Mansey et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Mansey et al.** so as to provide continuous tracking and displaying of the running costs during usage of the service and allows the user to define a maximum cost limit for a particular use of the service, for example (see column 2, lines 21-32).

As per claims 3, 4, 6, 22, 30, and 56, **Mansey et al.** discloses the limitation of placing a contract for a particular usage that meets the recitation of wherein the contract does not depend on a previous or subsequent relationship between client and service provider. **Mansey et al.** also discloses a user of a client computer may monitor and control of client usage, for example (see column 2, lines 1-5 and lines 27-31). Therefore, these claims are rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claim 5 and 55, Van Horne et al. discloses the limitation of wherein the client's usage is measured by bytes or packets transmitted or received, or by the contract's active or elapsed time, for example (see column 19, line 59 through column 20, line 40; and column 21, lines 1-15).

As per claims 7, Van Horne et al. discloses the limitation of wherein the client may choose a hard usage limit, such that the service provider terminates the contract when the hard limit is reached, for example (see column 17, lines 12-36).

As per claim 8, Van Horne et al. discloses the limitation of where, after receiving a deposit, the service provider sends to the client computer a receipt that the client computer may use to recover from a client computer or service provider failure, obtaining access again on the same contract, for example (see column 17, line 4 through column 18, line 12).

As per claim 9, Van Horne et al. discloses the limitation of wherein the receipt contains all the information required for recovery, for example (see column 17, line 4 through column 18, line 12).

As per claim 10, Van Horne et al. discloses the limitation of wherein the contract is established and the client may monitor and control its usage via a Transport Layer Security protocol or via a Secure Socket Layer connection as discussed above, for example (see columns

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16-17) and **Mansey et al.** discloses establishing a contract. Therefore, claim 10 is rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claims 11 and 12, Van Horne et al. discloses the limitation of wherein the service provider owns or rents the premises at the point of access, wherein access is provided in one of an airport, hotel, conference center, or a multi-tenant building for example (see column 4, lines 54-65).

As per claim 13, Van Horne et al. discloses the limitation of wherein a service provider that provides the client access obtains access services from another service provider, e.g., an Internet Service Provider (ISP), for example (see column 6, lines 35-65 and column 1, lines 20-52).

As per claim 14, Van Horne et al. discloses the limitation of wherein a service provider that provides client access is connected to the Internet by one or more Digital Subscriber Lines (DSL), T1 or other dedicated telephone lines, Integrated Services Digital Network (ISDN) lines, or cable modems, for example (see column 7, lines 50-65).

As per claims 15 and 17, Garrett et al. discloses the limitation of wherein a service provider that provides the client access uses Network Address Translation, for example (see page 1, paragraph 0002 and 0010), and wherein the network configuration of client computers is performed by the Dynamic Host Configuration Protocol, for example (see page 2, paragraph

0019). Therefore, claims 15 and 17 are rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claim 16, Van Horne et al. discloses the limitation of wherein the network configuration of client computers is automatic, for example (see column 11, lines 32-35).

Claims 18-20 recite authentication of packets between the service provider and the client and encrypting packets, which was discussed in claims 1 and 23 above. Therefore, claims 18-20 are rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claim 21, Garrett et al. discloses the limitation of wherein the client computer may choose whether packets sent from or via a service provider to the client computer should be authenticated, or whether packets sent between the client computer and a service provider should be encrypted, for example (see page 3, paragraph 0024) and is also well known in the art as discussed in RFC 1826. Therefore, claim 21 is rejected on the same rationale as the rejection of claims 1 and 23 above.

As per claims 23 and 24, Mansey et al. discloses the limitation of wherein the client may choose a soft usage limit, such that the service provider suspends service to the client when the soft limit is reached and sends a notification to the client, and the client may resume service and set a new soft limit by sending a message to the service provider, further comprising the client paying for said Internet or other network service, wherein the payment is offline, for

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example (see column 6, lines 5-37). Therefore, claims 23 and 24 are rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claims 25-29, Van Horne et al. discloses the limitation of wherein payment is by one or more of the following options: cash, credit card, and debiting from another account and further comprising the client paying for said Internet or other network service, wherein the payment is online, for example (see column 13, line 49 through column 14, line 36). It is obvious that the online payment can be performed by one of the companies eCASH®, SECURE ELECTRONIC TRANSACTIONS (SET)®, IBM MICROPAYMENTS®, or MILLICENT®.

As per claims 31-32, Van Horne et al. discloses the limitation of wherein the user of the client computer, before gaining service pays to the service provider a deposit, and, when the user requests contract termination, the service provider returns to the user the difference between the deposit and actual usage for example (see column 19, line 59 through column 20, line 40; and column 21, lines 1-15). It is apparent to one skilled in the art that the service provider returns to the user the balance, which is the difference between the deposit and actual usage.

As per claims 33-35, Van Horne et al. discloses the limitation of wherein the client computers are not portable and wherein the client computers are portable, wherein the client computers are wearable, for example (see column 6, lines 35-65).

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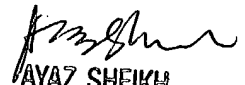
Claims 36-48 and 54 recite standard Internet Protocols well known in the art discussed above in claim 1, for example (see RFC documentation). Therefore, claims 36-48 and 54 are rejected on the same rationale as the rejection of claims 1 and 53 above.

As per claims 49, 51, and 52, Garrett et al. discloses the limitation of wherein the user of the client computer does not reveal its identity to the service provider, for example (see page 4, paragraph 0031) and also discloses wherein service provider functionality is implemented by an integrated router/server or implemented by separate router and server, for example (see page 2, paragraph 0013). Therefore, claims 49, 51, and 52 are rejected on the same rationale as the rejection of claims 1 and 53 above.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of network address translations in network services and establishing secure tunnel with service provider. Many of the claimed features, i.e. secure tunnel with Ipsec, Internet protocol authentication, encryption etc. are disclosed in these references.

| | | |
|-----------------------|-----------------|-------------------|
| US Patent Publication | US 2002/0026503 | Bendinelli et al. |
| US Patents | 6,055,236 | Nessett et al. |
| | 5,805,803 | Birrell et al. |


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